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EXAMINER

JERABEK, KELLY L

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/666,388

Applicant(s)

GIBELEY ET AL.

Examiner

Kelly L. Jerabek

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 9, 10, 12-29 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 9, 10, 12-29 and 31-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/9/2007 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-4, 7, 9-10, 12-29 and 31-34 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 11/9/2007 have been fully considered but they are not persuasive.

Response to Remarks:

Applicant's arguments regarding claims 14 and 15 (Amendment pages 8-9) state that the Robins reference does not disclose a removable memory card that includes a first portion of the memory that is electronically readable by a supplier but not by a digital camera. The Examiner respectfully disagrees. Robins discloses a digital camera that has a remote enable/disable capability. The camera (100) disclosed by Robins includes a removable memory card (134) that includes an identifier (221) that is used by a rental entity to track image capturing devices. The Robins reference does not disclose that the identifier is electronically readable by the digital camera (100), therefore Robins discloses a first portion of memory (221) that is electronically readable by a supplier (rental entity) but not by the digital camera provided by the photographer, and a second portion of memory (223) that is electronically readable by the supplier and the digital camera provided by the photographer (figure 2; page 2, paragraphs 26-30).

Official Notice Not Traversed, Now AAPA

Re claim 10, Official Notice was taken in the most recent Office Action regarding the well-known practice of prepayment for goods or services and then providing a credit for unused goods or services previously purchased. The Examiner's conclusion of common knowledge in the art is now taken to be admitted prior art because Applicant has failed to traverse the Examiner's assertion of Official Notice in reply to the Office

Action in which the common knowledge statement was made. Please see MPEP § 2144.03.

Re claims 12-13, Official Notice was taken in the most recent Office Action regarding the well-known practice of providing a debit card, associated with a bank or financial institution, to a provider of goods or services in order to provide authorization for payment, and then later providing the debit card again to provide payment for the goods or services once rendered, such as for the prior authorization and then payment of a hotel stay by way of a debit card. The Examiner's conclusion of common knowledge in the art is now taken to be admitted prior art because Applicant has failed to traverse the Examiner's assertion of Official Notice in reply to the Office Action in which the common knowledge statement was made. Please see MPEP § 2144.03.

Re claim 18, Official Notice was taken in the most recent Office Action regarding the well-known practice of providing a claim card to an individual who is transferring control of an item, in order to associate an individual with an item, and then that individual presenting the card in order to reclaim control of that item at a later point in time. The Examiner's conclusion of common knowledge in the art is now taken to be admitted prior art because Applicant has failed to traverse the Examiner's assertion of Official Notice in reply to the Office Action in which the common knowledge statement was made. Please see MPEP § 2144.03.

Re claim 19, Official Notice was taken in the most recent Office Action regarding the well-known practice of providing a removable tag to an individual who is transferring control of an item, in order to associate that individual with an item, and then that individual presenting the tag in order to reclaim control of that item. The Examiner's conclusion of common knowledge in the art is now taken to be admitted prior art because Applicant has failed to traverse the Examiner's assertion of Official Notice in reply to the Office Action in which the common knowledge statement was made. Please see MPEP § 2144.03.

Re claim 23, Official Notice was taken in the most recent Office Action regarding the well-known practice of writing a test pattern onto a memory device in order to verify its functionality. The Examiner's conclusion of common knowledge in the art is now taken to be admitted prior art because Applicant has failed to traverse the Examiner's assertion of Official Notice in reply to the Office Action in which the common knowledge statement was made. Please see MPEP § 2144.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robins et al. US 2003/0151669 in view of Reifel et al. US 7,013,288.

Re claims 31 and 33, Robins discloses a digital camera (100) including a removable memory card (134); the removable memory card (134) comprising a first portion of memory (221) that is electronically readable by a rental entity by not by the digital camera (100), and a second portion of memory (223) that is electronically readable by the rental entity and by the digital camera (100) (page 2, paragraphs 26-30; figures 1 and 2). However, although the Robins reference discloses all of the above limitations it fails to specifically disclose a photofinishing services provider and it fails to disclose that the first portion of the memory includes a code for indicating to a photofinishing services provider that the removable memory card carries with it a commitment to create prints.

Reifel discloses a consumer being supplied with a similar memory device that bears a code that indicates to the photofinisher that the memory device carries with it the commitment to create prints (fig. 9; col. 4 lines 20-23). Reifel further states that a consumer profile regarding the consumers that have committed to create prints is built up and transferred to a customer database (27)) (col. 11, line 50-col. 12, line 38). It would have been obvious to one of ordinary skill in the art at the time of the invention to include a code for verifying that a consumer has a commitment to create prints as

taught by Reifel in the first portion of the memory device disclosed by the Robins reference in order to visually indicate that the commitment has been entered into and the extent of the commitment, e.g. the number of prints to create.

Re claims 32 and 34, Reifel discloses a consumer being supplied with a similar memory device that bears a code that indicates to the photofinisher that the memory device carries with it the commitment to create prints (fig. 9; col. 4 lines 20-23). Reifel further states that a consumer profile regarding the consumers that have committed to create prints is built up and transferred to a customer database (27)) (col. 11, line 50-col. 12, line 38). In addition, Robins states that the first portion (221) of memory contains a unique ID (serial number or other identifier) (figure 2; page 2, paragraph 30). Therefore, it would have been obvious to store the code indicating a commitment to create prints as disclosed by Reifel in the first portion (221) of the memory as disclosed by Robins.

Claims 1, 7, 9, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 and further in view of Reifel et al. US 7,013,288.

Re claim 1, Kubota discloses a method of providing photofinishing services, comprising the steps of: supplying to a photographer at least one removable memory

device (122) selected from a variety of available formats and having a format appropriate for use in the digital camera (120) provided by the photographer (figure 8; page 6, paragraph 119); the photographer photographing, downloading or transferring from other electronic devices, a plurality of digital images for storage on the at least one removable memory device (page 2, paragraph 51); the photographer delivering the at least one removable memory device (122) containing the digital images to a photofinisher (130) (page 6, paragraph 121); the photofinisher (130) producing prints of the digital images and returning the prints to the photographer (page 6, paragraphs 122-123); and the photofinisher (130) erasing the digital images from the at least one removable memory device (122) and preparing the at least one memory device (122) to be supplied to another photographer to repeat the steps above (page 6, paragraphs 124-128). However, although the Kubota reference discloses all of the above limitations it fails to state that the photographer may optionally delete some or all of the digital images on the removable memory device.

Nanba discloses a digital photographing apparatus. Nanba states that the digital camera includes a delete key (D) for deleting the images recorded in a memory card (8) (col. 3, lines 33-49). Therefore, it would have been obvious for one skilled in the art to have been motivated to include an optional deleting function allowing a user to delete images stored on a memory card of a digital camera as disclosed by Nanba in the digital camera of the system disclosed by Kubota. Doing so would provide a means for allowing a user to capture images and delete the images that the user does not want in order to free up memory space on the removable memory.

Although the combination of the Kubota and Nanba references discloses all of the above limitations, it fails to disclose that the photofinisher reads a code stored on the removable memory device and accesses a database having stored therein data corresponding to the code for verifying that the removable memory device carries with it a commitment to create prints.

Nevertheless, Reifel discloses a consumer being supplied with a similar memory device that bears a code that indicates to the photofinisher that the memory device carries with it the commitment to create prints (fig. 9; col. 4 lines 20-23). Reifel further states that a consumer profile regarding the consumers that have committed to create prints is built up and transferred to a customer database (27)) (col. 11, line 50-col. 12, line 38). It would have been obvious to one of ordinary skill in the art at the time of the invention to include a code for verifying that a consumer has a commitment to create prints as taught by Reifel with the memory device of the method as taught by the combination of Kubota and Nanba in order to visually indicate that the commitment has been entered into and the extent of the commitment, e.g. the number of prints to create.

Re claim 7, Kubota states that the removable memory device (122) comprises a compact flash (CF) format (page 6, paragraph 130).

Re claim 9, Reifel discloses a consumer being supplied with a memory device that indicates that a consumer has a commitment to create prints (fig. 9; col. 4 lines 20-

23). Therefore, it can be seen that the memory device must include some graphic to indicate that the consumer has a commitment to create prints.

Re claim 24, Reifel discloses a consumer being supplied with a similar memory device that displays prerecorded image such as an advertisement (col. 10 lines 9-48).

Re claim 26, Reifel further discloses a step of selling advertising space in the prerecorded image (col. 9 line 52 – col. 10 line 48.)

Claims 2 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 in view of Reifel et al. US 7,013,288 and further in view of Takano US 2001/0041072.

Re claim 2, the combination of the Kubota, Nanba and Reifel references discloses all of the limitations of claim 1 above. However, neither reference states that the photofinisher produces index print and/or CD of the digital images from the memory device and returns the index print and/or CD to the photographer. However, Kubota does state that the images may be printed out by the photofinisher.

Nevertheless, Takano discloses producing and providing an index print to a digital image customer (figure 18; pages 5-6 paragraphs 83-84). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a print index as taught by Takano with the method as taught by the combination of Kubota,

Nanba and Reifel so that the customer may take the physical print index with them, so that they do not have to immediately decide with prints to purchase upon submission of the memory device.

Re claim 28, the combination of the Kubota, Nanba and Reifel references discloses all of the limitations of claim 1 above. However, neither reference states that the photofinisher produces index print and/or CD of the digital images from the memory device and returns the index print and/or CD to the photographer, wherein the index print includes a printed filename of a corresponding image file recorded on the CD. However, Kubota does state that the images may be printed out by the photofinisher.

Nevertheless, Takano discloses producing and providing an index print to a digital image customer in which the image is assigned a number corresponding to the digital image (figure 2 indicator 76, figure 18 indicator 706; pages 5-6 paragraphs 83-84), as well as producing a CD on which the corresponding digital images are stored (figure 5, indicator 24 and 63; page 7, paragraph 101). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a print index and CD, with corresponding image labels/names as taught by Takano with the method as taught by the combination of Kubota, Nanba and Reifel so that the customer may take the physical print index with them, so that they do not have to immediately decide with prints to purchase upon submission of the memory device.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 further in view of Reifel et al. US 7,013,288 in view of Takano US 2001/0041072 and further in view of Parulski et al. US 2003/0025808.

Re claim 3, the combination of the Kubota, Nanba, Reifel and Takano references discloses all of the limitations of claim 2 above. Additionally, Takano discloses providing an index print to a digital image customer in which the image is assigned a number corresponding to the digital image (figure 2 indicator 76, figure 18 indicator 706; pages 5-6 paragraphs 83-84), as well as producing a CD on which the corresponding digital images are stored (figure 5, indicator 24 and 63; page 7, paragraph 101). However, the combination fails to disclose that the removable memory device contains N digital images and also indicates that M prints have been promised, where M is less than N.

Parulski discloses a digital camera that includes a user interface that allows a camera user to create a print order "utilization file". Parulski states that using the camera user interface the user can select desired downstream services such as printing images selected by the user in order to create a utilization file that is subsequently stored on a memory card (36) (page 2, paragraph 17). Therefore, it would have been obvious for one skilled in the art to have been motivated to store a utilization file including a print order for images selected by a user as disclosed by Parulski in the removable memory device of the photofinishing system disclosed by the combination of

Kubota, Nanba, Reifel and Takano. Doing so would provide a means for allowing a user to designate a certain number of captured images to be printed out.

Re claim 4, Takano discloses an index print and/or a CD containing all N of the digital images on the memory device and indicates which images have or have not been printed (figure 18; page 4, paragraph 67; pages 5-6, paragraphs 82-84, in which a completed and fulfilled index print would inherently contain the images and indicate the images that had been printed).

Claims 10, 12-13, 18-19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 further in view of Reifel et al. US 7,013,288 and further in view of the Applicant's Admitted Prior Art.

Re claim 10, the combination of the Kubota, Nanba and Reifel references discloses all of the limitations of claim 1 above. In addition, Reifel discloses a consumer being supplied with a similar memory device in which a contract for photofinishing services is entered into in exchange for a reduced price of the memory device (col. 4 lines 20-23). Further, the applicant's admitted prior art discloses the well-known practice of prepayment for goods or services and then providing a credit for unused goods or services previously purchased. It would have been obvious to one of ordinary skill in the art at the time of the invention for a user to prepay for images to be printed

from the memory device and method taught by Kubota, Nanba and Reifel, as a way to provide advanced notice to the photofinisher that a certain number of images will potentially be ordered, thereby assisting in the prediction of available cash flow and more accurate bookkeeping, and then to further provide a credit for the unused image amounts so that the user is fairly charged for the only prints produced, and so that a more equitable business arrangement would also be created.

Re claim 12, the combination of the Kubota, Nanba and Reifel references and applicant's admitted prior art discloses all of the limitations of claim 10 above. However, the combination fails to disclose that the credit is in the form of a debit card that is returned with the prints.

Nevertheless, the applicant's admitted prior art discloses the well-known practice of providing a debit card as a form of credit. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the credit in the form of a debit card in order to prevent the credit from being applied elsewhere, and therefore assisting in retaining business profits previously predicted and accounted.

Re claim 13, the combination of the Kubota, Nanba and Reifel references discloses all of the limitations of claim 1 above. Additionally, Reifel discloses a consumer being supplied with a similar memory device in which a contract for photofinishing services is entered into in exchange for a reduced price of the memory device (col. 4 lines 20-23.) Further, the applicant's admitted prior art discloses the well-

known practice of providing a debit card, associated with a bank or a financial institution, to a provider of goods or services in order to provide authorization for payment, and then later providing the debit card again to provide payment for the goods or services once rendered, such as for the prior authorization and then payment of a hotel stay by way of a debit card. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ a debit card in an analogous manner in which a debit card would be presented to the photofinisher for authorization for photofinishing services, and then given back to the user along with the memory device, and then presented again along with the memory device when the photofinishing services were to actually be provided, and in doing so, fulfilling the quid pro quo arrangement of money for goods and services.

Re claim 18, the combination of the Kubota, Nanba and Reifel references discloses all of the limitations of claim 1 above. However, the combination fails to disclose that the method further comprises the steps of supplying a claim card for retrieving photofinishing services to the photographer along with the memory device and presenting the claim card to the photofinisher to retrieve the photofinishing order. However, Kubota does disclose that the external storage medium (122) can be identified therefore there is an inherent external storage medium password or identifier (page 6, paragraphs 128-130).

Nevertheless, applicant's admitted prior art discloses the well-known practice of providing a claim card to an individual who is transferring control of an item, in order to

associate an individual with an item, and then that individual presenting the card in order to reclaim control of that item at a later point in time, similar to the method employed in the dry cleaning industry or with valet parking. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ a claim card in an analogous manner with the method as taught by the combination of the Kubota, Nanba and Reifel references in order to associate the memory device and the corresponding order with the user in an analogous manner.

Re claim 19, the combination of the Kubota, Nanba and Reifel references discloses all of the limitations of claim 1 above. However, the combination fails to disclose that the method further comprises the steps of supplying a removable tag for retrieving photofinishing services to the photographer along with the memory device and presenting the removable tag to the photofinisher to retrieve the photofinishing order. However, Kubota does disclose that the external storage medium (122) can be identified therefore there is an inherent external storage medium password or identifier (page 6, paragraphs 128-130).

Nevertheless, the applicant's admitted prior art discloses the well-known practice of providing a removable tag to an individual who is transferring control of an item, in order to associate that individual with an item, and then that individual presenting the tag in order to reclaim control of that item, similar to the method employed in the dry cleaning industry or with valet parking. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ a removable tag with the method as

taught by the combination of Kubota, Nanba and Reifel in order to associate the memory device and the corresponding order with the user in an analogous manner.

Re claim 23, the combination of the Kubota, Nanba and Reifel references discloses all of the limitations of claim 1 above. However, the combination fails state that the step of erasing the digital images from the memory device includes writing a test pattern onto the memory device.

The applicant's admitted prior art discloses the well-known practice of writing a test pattern onto a memory device in order to verify its functionality; a concept that is well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to include writing a test pattern onto the memory device as not only a way to verify its functionality, but also as a tool to effectively erase the digital images from the memory device by overwriting them with the test pattern.

Claims 14-15 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 in view of Reifel et al. US 7,013,288 and further in view of Robins et al. US 2003/0151669.

Re claim 14, the combination of Kubota, Nanba and Reifel discloses all of the limitations of claim 1 above. However, the combination fails to specifically state that the removable memory device includes a first portion of memory that is electronically

readable by a supplier and the photofinisher but not by the digital camera provided by the photographer, and a second portion of memory that is electronically readable by the supplier, the photofinisher, and the digital camera provided by the photographer.

Robins discloses a digital camera that has a remote enable/disable capability. The camera (100) disclosed by Robins includes a removable memory card (134) that includes an identifier (221) that is used by a rental entity to track image capturing devices. The Robins reference does not disclose that the identifier is electronically readable by the digital camera (100), therefore Robins discloses a first portion of memory (221) that is electronically readable by a supplier (rental entity) but not by the digital camera provided by the photographer, and a second portion of memory (223) that is electronically readable by the supplier and the digital camera provided by the photographer (figure 2; page 2, paragraphs 26-30). Therefore, it would have been obvious for one skilled in the art to have been motivated to include the memory including a memory area that is only controllable by the supplier as disclosed by Robins and the photofinishing system disclosed by the combination of Kubota, Nanba and Reifel. Doing so would provide a means for allowing a distributor of the memory card to track the memory card and to control the use of the memory card by a user.

Re claim 15, Robins further states that the first portion (221) of memory contains a unique ID (serial number or other identifier) (figure 2; page 2, paragraph 30). Therefore, it would have been obvious to store the code indicating a commitment to

create prints as disclosed by Reifel in the first portion (221) of the memory as disclosed by Robins.

Re claim 27, the combination of Kubota, Nanba and Reifel discloses all of the limitations of claim 1 above. However, the combination fails to specifically state that the removable memory device includes a code in a file hidden from electronic access by the photographer or in a pseudo bad sector of its memory that is inaccessible electronically by the photographer that indicates to the photofinisher that the at least one removable memory device carries with it a commitment to create prints.

Robins discloses a digital camera that has a remote enable/disable capability. The camera disclosed by Robins includes a removable memory card (134) that includes a first portion of memory (221) that includes a code in a file hidden from electronic access by the photographer or in a pseudo bad sector of its memory that is inaccessible electronically by the photographer that indicates to the photofinisher that the at least one removable memory device carries with it a commitment to create prints (figure 2; page 2, paragraphs 26-30). Therefore, it would have been obvious for one skilled in the art to have been motivated to include the memory including a memory area that is only controllable by the supplier as disclosed by Robins in the photofinishing system including a code indicating a commitment to create prints as disclosed by the combination of Kubota, Nanba and Reifel. Doing so would provide a means for allowing a distributor of the memory card to track the memory card and to control the use of the memory card by a user.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 in view of Reifel et al. US 7,013,288 in view of Robins et al. US 2003/0151669 and further in view of Yamashina et al. JP 05-093950.

Re claim 16, the combination of the Kubota, Nanba, Reifel and Robins references discloses all of the limitations of claim 14 above. However, the combination fails to specifically state that the protected memory area contains a number indicating the number of times that the memory device has been recycled.

Nevertheless, Yamashina discloses indicating the number of times a camera component has been recycled (Abstract.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include the number of times the memory device has been recycled within the protected memory area as taught by Yamashina with the method as taught by the combination of Kubota, Nanba, Reifel and Robins in order to help maintain a stable level of quality.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 in view of Reifel et al. US 7,013,288 in view of Robins et al. US 2003/0151669 and further in view of Okada et al. US 2001/0040625.

Re claim 17, the combination of the Kubota, Nanba, Reifel and Robins references discloses all of the limitations of claim 14 above. However, the combination fails to specifically state that the first portion of memory contains instructions for the photofinisher provided by the supplier.

Okada discloses a digital camera capable of being collected for reuse. Okada discloses a memory area that contains instructions for the photofinisher provided by the supplier (page 5, paragraph 86 and page 4, paragraph 63, which includes providing information to correspond the image data with a particular homepage address). Therefore, it would have been obvious for one skilled in the art to have been motivated to store instructions for the photofinisher as disclosed by Okada in the first portion of the memory disclosed by the combination of the Kubota, Nanba, Reifel and Robins references. Doing so would provide a means for effectively identifying images and easily producing a print of an image.

Claims 20-21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 in view of Reifel et al. US 7,013,288 and further in view of Okada.

Re claim 20, the combination of the Kubota, Nanba and Reifel references discloses all of the limitations of claim 1 above. However, the combination fails to disclose that the method further comprises the step of writing an identifier unique to the

photographer on the at least one removable memory device and presenting the identifier unique to the photographer to the photofinisher to retrieve the photofinishing services. However, Kubota does disclose that the external storage medium (122) can be identified therefore there is an inherent external storage medium password or identifier (page 6, paragraphs 128-130).

Okada discloses a digital camera system including a digital camera capable of being collected for reuse. The camera (10) disclosed by Okada stores photographed image data (73a) and an identification code (73b) for identifying an individual camera (10). The system also includes a memory card (74) that stores a URL and a password (74a) for obtaining photographed data (page 6, paragraph 101). Okada further states that a user may give their email address to the selling store in order to receive the password and URL by email (page 6, paragraphs 110-11). Therefore, it would have been obvious for one skilled in the art to have been motivated to write an identifier unique to the photographer as disclosed by Okada in the memory disclosed by the combination of the Kubota, Nanba and Reifel references and present the identifier in order to retrieve photofinishing services. Doing so would provide a means for effectively identifying a photographer and allowing a photofinisher to easily produce a print of an image and distribute it to the photographer.

Re claim 21, the combination of the Kubota, Nanba and Reifel references discloses all of the limitations of claim 1 above. However, the combination fails to disclose that the method further comprises the step of writing a phone number or e-mail

address of the photographer on the at least one removable memory device and presenting the phone number or e-mail address to the photofinisher to retrieve the photofinishing services. However, Kubota does disclose that the external storage medium (122) can be identified therefore there is an inherent external storage medium password or identifier (page 6, paragraphs 128-130).

Okada discloses a digital camera system including a digital camera capable of being collected for reuse. The camera (10) disclosed by Okada stores photographed image data (73a) and an identification code (73b) for identifying an individual camera (10). The system also includes a memory card (74) that stores a URL and a password (74a) for obtaining photographed data (page 6, paragraph 101). Okada further states that a user may give their email address to the selling store in order to receive the password and URL by email (page 6, paragraphs 110-11). Therefore, it would have been obvious for one skilled in the art to have been motivated to write an identifier unique to the photographer as disclosed by Okada in the memory disclosed by the combination of the Kubota, Nanba and Reifel references and present the identifier in order to retrieve photofinishing services. Doing so would provide a means for effectively identifying a photographer and allowing a photofinisher to easily produce a print of an image and distribute it to the photographer.

Re claim 25, the combination of the Kubota, Nanba and Reifel references discloses all of the limitations of claim 24 above. However, the combination fails to

specifically state that the prerecorded image contains instructions to the photographer for using the photofinishing services.

Okada discloses a digital camera capable of being collected for reuse. Okada discloses a memory area that contains instructions to the photographer for using the photofinishing services (page 5, paragraph 86 and page 4, paragraph 63, figure 1A and 1B which includes providing information to correspond the image data with a particular homepage address). Therefore, it would have been obvious for one skilled in the art to have been motivated to store instructions for the photofinisher as disclosed by Okada in the first portion of the memory disclosed by the combination of the Kubota, Nanba and Reifel references. Doing so would provide a means for effectively identifying images and easily producing a print of an image.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 in view of Reifel et al. US 7,013,288 in view of Okada et al. US 2001/0040625 and further in view of Maginess et al. US 4,870,257.

Re claim 22, the combination of the Kubota, Nanba and Reifel references discloses all of the limitations of claim 1 above. However, the combination fails to disclose that the method further comprises the step of writing a phone number or e-mail address of the photographer on a photofinishing envelope and presenting the phone number or e-mail address to the photofinisher to retrieve the photofinishing services.

However, Kubota does disclose that the external storage medium (122) can be identified therefore there is an inherent external storage medium password or identifier (page 6, paragraphs 128-130).

Okada discloses a digital camera system including a digital camera capable of being collected for reuse. The camera (10) disclosed by Okada stores photographed image data (73a) and an identification code (73b) for identifying an individual camera (10). The system also includes a memory card (74) that stores a URL and a password (74a) for obtaining photographed data (page 6, paragraph 101). Okada further states that a user may give their email address to the selling store in order to receive the password and URL by email (page 6, paragraphs 110-11). Therefore, it would have been obvious for one skilled in the art to have been motivated to write an identifier unique to the photographer as disclosed by Okada in the memory disclosed by the combination of the Kubota, Nanba and Reifel references and present the identifier in order to retrieve photofinishing services. Doing so would provide a means for effectively identifying a photographer and allowing a photofinisher to easily produce a print of an image and distribute it to the photographer. However, although the combination of the Kubota, Nanba, Reifel and Okada references disclose all of the above limitations none of the references discloses wiring a phone number or e-mail address of the photographer on a photofinishing envelope.

Maginness discloses a photofinishing method in which a user provides their name and address on a photofinishing envelope containing image information to be produced as prints (col. 3 lines 38 – col. 4 line 27.) In light of the teachings of

Maginness, it would have been obvious to one of ordinary skill in the art at the time of the invention to employ a photofinishing envelop to hold the memory device, in which the photofinishing envelope had the phone number or e-mail address of the photographer on it instead of on the memory device, with the method of the combination of Kubota, Nanba, Reifel and Okada in which a phone number or e-mail address is used to retrieve the photofinishing order, in order to provide a way to transport the memory device without exposing the password to a possible unauthorized user, while still being able to associate the memory device with the intended user for retrieval of the photofinishing order.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 in view of Reifel et al. US 7,013,288 in view of Takano US 2001/0041072 and further in view of Hunter US 7,139,095.

Re claim 29, the combination of the Kubota, Nanba and Reifel references discloses all of the limitations of claim 1 above. However, neither reference states that the method further comprising the steps of the photofinisher producing at least one print and a CD of the digital images from the memory device and returning the at least one print and CD to the photographer, and indicating on the at least one print the filename of the corresponding image file recorded on the CD. However, Kubota does state that the images may be printed out by the photofinisher.

Nevertheless, Takano discloses producing and providing an index print to a digital image customer in which the image is assigned a number corresponding to the digital image (figure 2 indicator 76, figure 18 indicator 706; pages 5-6 paragraphs 83-84), as well as producing a CD on which the corresponding digital images are stored (figure 5, indicator 24 and 63; page 7, paragraph 101). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a print index and CD, with corresponding image labels/names as taught by Takano with the method as taught by the combination of Kubota, Nanba and Reifel so that a customer may take the physical print index with them so that they do not have to immediately decide which prints to purchase upon submission of the memory device, and so that they are not required to use a computer or other device to view potential images, as well as providing a logical method of using the CD to make later print selections by way of matching image numbering convention. However, neither Kubota, Nanba, Riefel nor Takano disclose indicating on the at least one print the filename of the corresponding image file recorded on the CD.

Hunter discloses producing a print in which a unique identifier and image number are provide, the unique identifier and image number corresponding to that found in the digital memory (fig. 7; col. 4 lines 25-61.) It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the use of a unique identifier and an image number on a print containing an image that corresponds to a digital version of the image, with the method as taught by Kubota, Nanba, Reifel and Takano, so that a

user can quickly identify the image, via the identifier or number, for creating additional printouts.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly L. Jerabek whose telephone number is **(571) 272-7312**. The examiner can normally be reached on Monday - Friday (8:00 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye can be reached on **(571) 272-7372**. The fax phone number for submitting all Official communications is **(571) 273-7300**. The fax phone number for submitting informal communications such as drafts, proposed amendments, etc., may be faxed directly to the Examiner at **(571) 273-7312**.

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